



ATTORNEY DOCKET NO. 11596.0054

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Group Art Unit: 2617

MARTIN P. USHER ET AL

Examiner: Kiet M. Doan

Serial No.: 10/069,100

Filed: October 21, 2002

For: COMMUNICATION BETWEEN A
FIXED NETWORK AND A MOVABLE
NETWORK WITH MEANS FOR
SUSPENDING OPERATION OF THE
MOVABLE NETWORK

APPLICANTS' REPLY BRIEF

Commissioner of Patents
Customer Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Sir:

In response to the Examiner's Answer of December 12, 2007, herein follows Applicants' Reply Brief.

I. ARGUMENT

A. The Answer Withdraws the Rejection under 35 U.S.C. § 112, and should thus be reversed.

Applicants acknowledge the Examiner's express withdrawal of the pending rejection under 35 U.S.C. § 112. Answer, page 6. In view of the withdrawal of the rejection, Applicants' arguments on the point are now moot.

B. The Rejected Claims are Patentably Distinct over the § 103 Combination of Zicker and McConnell.

1. Claims 9 and 13

Claim 9 and 13 are the two pending independent claims on appeal. By way of summary, both claims 9 and 13 require the simultaneous suspension/discontinuation of forwarding incoming calls based on a control signal and that such simultaneous suspension/discontinuation does not affect any calls in progress. The Office Action rejects independent claims 9 and 13 under 35 U.S.C. § 103 as obvious over Zicker in view of McConnell et al. ("McConnell").

The rejection of claims 9 and 13 as set forth in prior Office Actions and the Answer on pages 3-4 unequivocally states that the primary Zicker reference does not disclose incoming call suspension that does not affect calls in progress. Thus, as stated in the Answer: "Zicker teaches the limitation of claim as discuss **but silent on simultaneous suspending . . .** wherein said suspending forwarding incoming calls does not disconnect a call in progress between and any of the plurality of users and the fixed network." Answer at 3-4 (emphasis in original). To provide what was lacking from Zicker, the Office Action turned to McConnell for those teachings.

In response, Applicants' Appeal Brief concurred with the Examiner's conclusion that Zicker is silent on the noted terms, and pointed out in detail how the McConnell reference did not provide the simultaneous suspensions/discontinuation without interfering with calls in

progress that the Examiner attributed to McConnell. Thus, the combination of Zicker and McConnell fails to teach or suggest all of the elements of the rejected claims.

While the Answer restates the rejection and underlying rationale on pages 3-4 thereof on which the Appeal is based, the Answer makes no attempt to support that rationale, or to even engage on Applicants' arguments as raised in the Appeal Brief. Instead, the Examiner completely reverses course. Specifically, the Zicker reference now allegedly discloses the very claim limitations which the Examiner previously stated were not taught by Zicker. Similarly, the Examiner no longer relies on McConnell for those missing teachings. The Examiner has thus created an entirely new rationale for rejection that is completely inconsistent with the rationale of the rejection itself.

With respect to the original rationale of the rejection as set forth in page 3 of the Answer, the Examiner does not attempt to support that rationale, such that Applicants' arguments in the Appeal Brief stand uncontested.

With respect to the new rationale offered beginning at page 6 of the Answer, the Examiner alleges that the claim language for simultaneously suspending all calls without interfering with calls in progress – which was previously, expressly and repeatedly found not to be in Zicker at all – can now be found in Zicker at col. 12, lines 50-57. This text states:

When task 134 determines that cellular network 30 is in the active mode, a query task 137 determines if the call is through simulated A-side cellsite 33 of cellular network 30. If the call is being directed through simulated A-side cellsite 33, a task 138 selects A-side cellsite 33 and control transmissions on forward control channel 60 and reverse control channel 66 take place between radiotelephone 50 (FIG. 2) and A-side cellsite base station 52 (FIG. 2).

Nothing in this language refers to incoming call suspension without interference with a call in progress.

To the extent that the above citation to Zicker refers to an “active mode” of operation, then the surrounding text also discusses a “passive mode” that prevents any use of the phones during certain phases of flight. For example, Zicker specifically states at col. 11, lines 21-24, that the phones do not operate at all in passive mode: “By enabling cellular network 30 in the passive mode, all radiotelephones 50 will be prevented from participating in calls and making undesired radio frequency emissions.” (Emphasis added.) As a practical matter, if a call is in progress and the phone can suddenly no longer participate in the call, it is going to affect a call in progress. This is the exact opposite of the claim language at issue on appeal.

The Examiner nonetheless argues – without any citation or support - that somehow this language is broad enough to cover Applicants’ claim scope. Again, it is unclear how the Zicker reference went from being silent on the noted claim limitations to being so broad in its teachings as to cover the claim language. In any event, the Zicker operation is consistent with well-known current aircraft policy that prohibits the use of electronic devices during certain periods to prevent interference with aircraft operations. Zicker itself acknowledges this at col. 13, lines 59-62. Allowing calls to remain in progress during these periods, as the Examiner suggests, would be expressly counter to this requirement. Thus, even if this teaching of Zicker is an act of suspension, the Zicker methodology is the exact opposite of the claimed “said suspending forwarding incoming calls does not disconnect a call in progress between any of the plurality of users and the fixed network” as recited in claim 9, or similar language in claim 13.

As set forth in Applicants’ Appeal Brief, what is lacking from Zicker is not found in McConnell. The Answer does not contest Applicants’ analysis, such that Applicants’ arguments

are uncontested. Indeed, the Answer's sole reliance on McConnell is that it somehow "clarifies" the teachings of Zicker. The argument is somewhat amorphous, as it implies that Zicker really does teach the claimed invention, but one would only really see why when also reading McConnell. Applicants do not see how this is the case. While both references are in the field of telephone calls, the Examiner offers no basis for how McConnell "clarifies" anything about Zicker. Zicker deals with phone calls on aircraft, while McConnell deals with phone calls in hotels. There is no indication of common equipment, manufacturers, interest or intent that would somehow allow one of skill to read McConnell and gain insight into Zicker. As discussed above, Zicker is perfectly clear on its operation (the only pending ambiguity being the basis, if any, for the Examiner's reversal on Zicker's teachings).

Accordingly, claims 9 and 13, and claims dependent therefrom, are patentably distinct over the applied art. Reversal of the rejections and allowance of these claims are therefore requested.

2. Claim 16

Similar to claims 9 and 13, the Answer does a complete about face and changes its rationale from McConnell to Zicker. Specifically, the Examiner now claims that the previously silent Zicker now teaches sending a suspension control signal to a ground station that does not interfere with calls in progress. This argument is without merit for the reasons discussed above, *i.e.*, that the Zicker teachings which the Examiner relies upon for incoming call suspension does in fact interfere with calls in progress, which is the opposite of the claim language.

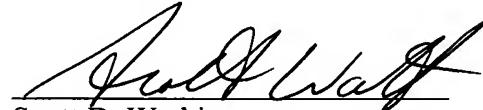
Accordingly, the teachings of McConnell, either alone or taken with Zicker, fail to either anticipate or render obvious the subject matter of claim 16. Reversal of the rejection is therefore requested.

II. CONCLUSION

As demonstrated above herein, the Zicker and McConnell references are inadequate, individually and collectively, as bases for rejection of any of Applicants' independent claims 9, 13 and 16. Claims 9 and 13 are also supported by the specification. Therefore, reversal of the stated rejections of those claims, and allowance of all claims are respectfully requested.

The PTO is hereby authorized to charge \$1030.00 for the Request for Oral Hearing attached hereto and to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293 (Order No. 11696.0054).

Respectfully submitted,



Scott D. Watkins
Reg. No. 36,715

February 11, 2008
Steptoe & Johnson LLP
1330 Connecticut Ave., N.W.
Washington, DC 20036
(202) 429-3000